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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,454

05/24/2006

Il Hwan Cho

1751-406

5516

6449

7590

12/08/2009

ROTHWELL, FIGG, ERNST & MANBECK, P.C.

1425 K STREET, N.W.

SUITE 800

WASHINGTON, DC 20005

EXAMINER

SOLOLA, TAOFIQ A

ART UNIT

PAPER NUMBER

1625

NOTIFICATION DATE

DELIVERY MODE

12/08/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/580,454	CHO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Taofiq A. Solola	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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Claims 1-8 are pending in this application.

Claim 4-7 are not elected.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 8, are rejected under 35 U.S.C. 102(a) as being anticipated by Park et al., J. Kor. Pharm. Sci. (Yakche Hakhoechi), (June, 2003), Vol. 33(2), pp. 105-112.

Park et al., disclose the compounds in page 109 and their composition. See also the attached abstract. By deleting R1 is H the rejection would be overcome.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Park et al., J. Kor. Pharm. Sci. (Yakche Hakhoechi), (June, 2003), Vol. 33(2), pp. 105-112.

Applicant claims compounds of formula I and composition thereof.

**Determination of the scope and content of the prior art (MPEP 2141.01)**

Park et al., disclose the compounds in page 109 and their composition. See also the attached abstract.

**Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)**

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The difference between the instant compounds and that of the prior art is that applicant replaces H with alkyl at position R1 in prior arts' compounds.

*Finding of prima facie obviousness--rational and motivation (MPEP 2142.2413)*

However, H and alkyl are art recognized equivalents. *In re Lincoln*, 126 USPQ 477, 53 USPQ 40 (CCPA, 1942); *In re Druey*, 319 F.2d 237, 138 USPQ 39 (CCPA, 1963); *In re Lohr*, 317 F.2d 388, 137 USPQ 548 (CCPA, 1963); *In re Hoehsema*, 399 F.2d 269, 158 USPQ 598 (CCPA, 1968); *In re Wood*, 582 F.2d 638, 199 USPQ 137 (CCPA, 1978); *In re Hoke*, 560 F.2d 436, 195 USPQ 148 (CCPA, 1977); *Ex parte Fauque*, 121 USPQ 425 (POBA, 1954); *Ex parte Henkel*, 130 USPQ 474, (POBA, 1960).

Therefore, the instant invention is prima facie obvious from the teaching of the prior art. One of ordinary skill in the art would have known to replaces H with alkyl at position R1 at the time the invention was made. The motivation is from the general knowledge in the art that H and alkyl are equivalents. By deleting R1 is alkyl the rejection would be overcome, or show unexpected result using instant utility. Such must be a side-by-side study.

***Response to Argument***

Applicant's arguments filed 10/13/09 have been fully considered but they are not persuasive. Applicant contends a Korean application (2002-0070450) is a counterpart of the instant application, was filed before the June 2003 publication date of the prior art cited above, and therefore above rejections must be withdrawn. This is not persuasive because the counterpart application is not claimed (not valid) as a priority document, and several inventors of the prior art are not inventors in the present application.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

/Taofiq A. Solola/

Primary Examiner, Art Unit 1625

December 1, 2009